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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,526	09/27/2001	Shinji Tomita	KPC-294	9267

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/963,526

Applicant(s)

TOMITA ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

*[Handwritten signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/20/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The new grounds of rejection as set forth below are necessitated by applicants' amendment filed 7/20/04 and thus, the following action is final.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(a) Claims 1 and 3 have each been amended to recite "said resin fine particles are one of solid and a powder". It is the examiner's position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the phrase "powder" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for the above amendment, applicants state that support can be found variously throughout the specification for example at page 15, lines 1-2. However, while this portion of the specification discloses that the fine polymer particle dispersion is dried to obtain resin fine

particles, this does not provide support for the recitation that the resin fine particles are a powder. There appears to be no disclosure of "powder" anywhere in the specification.

(b) Newly added claim 4 recites that the ratio of isocyanate group in component (D) to 1 equivalent of hydroxyl group in the (A) component is "greater than 2.0 equivalents and less than or equal to 4.0 equivalents". It is the examiner's position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the lower limit "greater than 2.0 equivalents" or upper limit of "less than 4.0 equivalents" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for the recitation of this phrase, applicants point to page 9, lines 2-12 of the present specification. However, while this portion of the present specification provides support for the recitation of lower limit of 2 or 2.2 and upper limit of 4 or 3.5, there is no support for the recitation of that the lower limit is "greater than 2.0 equivalents" or the upper limit is "less than 4.0 equivalents" which encompasses values of the lower limit of 2.05, 2.1, etc. and of the upper limit of 3.8, 3.9, etc. respectively, for which there is no support in the specification as originally filed.

Similar lack of support is found in newly added claims 5 and 7 which each recite the same upper limit of the ratio of isocyanate to hydroxyl group as claim 4.

**Claim Rejections - 35 USC § 103**

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al. (U.S. 6,706,801).

The rejection is adequately set forth in paragraph 5 of the office action mailed 4/20/04 and is incorporated here by reference.

With respect to the newly added limitation to claim 1 and claim 3 that the resin fine particles are one of a solid or powder, it is noted that col.14, lines 27-28 of Blum et al. disclose that the resin fine particles are in the form of aqueous dispersion or emulsion which would intrinsically possess a certain percentage of resin solids.

With respect to newly added claims 4-8, it is noted that with respect to the ratio of isocyanate group in the polyisocyanate to 1 equivalent of hydroxy group in the acrylic resin, it is noted that col.13, lines 35-36 of Blum et al. disclose that the ratio is at least 0.5 equivalents of polyisocyanate per equivalent hydroxyl group which clearly encompasses the ratios presently claimed.

**Response to Arguments**

6. Applicants' arguments filed 7/20/04 have been fully considered but they are not persuasive.

Specifically, applicants argue that Blum et al. is not a relevant reference against present claims 1-3 given that Blum et al. do not teach or suggest the resin fine particles in solid or powder form. As evidence to support this position, applicants note that Blum et al. discloses using organic or polymeric product in liquid state of 100% or as an aqueous dispersion or emulsion.

However, it is the examiner's position that when the resin is in the form of aqueous dispersion or emulsion, a portion of the resin is, in fact, in the form of solids. That is, an aqueous resin emulsion or resin dispersion necessarily contains a certain amount of solids attributed to the resin. Evidence to support this position is found, for instance, in col.18, lines 57-58 of Blum et al. which discloses emulsion copolymer with solids content of 43%.

Thus, it is clear that Blum et al. do disclose the use of resin fine particles that are solid and thus, Blum et al. remains a relevant reference against the present claims.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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